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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,869	11/02/1999	STEVEN W. BROWN	APPL-P2840	1715

7590 08/14/2003

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EXAMINER

RAY, GOPAL C

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 08/14/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/432,869

Applicant(s)

BROWN, STEVEN W.

Examiner

Gopal C. Ray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The examiner acknowledges the request for RCE with a Preliminary Amendment filed on 7/~~24~~/03. Claims 1-11 are presented for examination.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admitted prior art in view of US Patent 6,529,522 issued to Ito et al.

As per claim 1, applicant's admitted prior art teaches "creating a configuration ROM image for each link device; and presenting said configuration ROM image for each said link device" in Fig. 2, element 7 and page 4, lines 9-20.

Applicant's admitted prior art fails to teach "an individual configuration ROM image for each link device". However, the above feature was well known to one of ordinary skill in the art at the time the invention was made as evidenced by Ito et al. The reference of Ito et al. teaches the feature in Fig. 11 and

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col. 18, line 66 - col. 19, line 10. One of ordinary skill in the art at the time the invention was made would have realized that it is important to have an individual configuration ROM image for each link device for efficient and reliable operation of the computer system because that will enable to match the proper function and communication protocol of each device. The reference of Ito et al. teaches the motivation in col. 19, lines 8-10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the applicant's admitted prior art to implement "an individual configuration ROM image for each link device" because that would make the applicant's admitted prior art system more efficient and reliable.

As per claim 2, applicant's admitted prior art teaches "said configuration ROM image includes an entry for a distinct identifier for a corresponding link device" in Fig. 2, elements 5a, 5b and page 4, lines 9-20.

As per claim 3, applicant's admitted prior art teaches the added feature in Fig. 2, element 7 and page 4, lines 9-20.

As per claim 4, applicant's admitted prior art teaches

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"Wherein said creating and presenting said configuration ROM image is carried out by transaction layer software" in Fig. 2, element 6 and page 5, lines 13-16.

As per claims 5 and 6, the claims recite apparatuses which parallel method claims 1 and 2 respectively. In teaching the construction and use of the device, the combination of applicant's admitted prior art and US Patent 6,529,522 issued to Ito et al. teaches corresponding apparatuses.

As per claims 7 and 8, the claims are rejected for similar reasons as discussed in the rejection of claims 5 and 6 respectively.

As per claims 9-11, the claims are rejected for similar reasons as discussed in the rejection of claims 1-3 respectively with the exception of "a program storage device readable by a machine, tangibly embodying a program of instruction executable by the machine to perform the method". However, applicant's admitted prior art teaches the feature on page 4, lines 16-17.

4. Applicant's arguments filed on 7/~~24~~/03 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior

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art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reference of Ito et al. teaches the motivation in col. 19, lines 8-10.

Moreover, it is within the skill of an ordinary person in the art at the time the invention was made to create an individual configuration ROM image for each link device rather than one configuration ROM image for all link devices. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (703) 305-9647. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone numbers for this Group

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are (703) 746-7238 for "After-final", (703) 746-7239 "official" and (703) 746-7240 for "Non-official/Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**mark.rinehart@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2100 receptionist whose telephone number is (703) 305-3900.

*Gopal C. Ray*  
**GOPAL C. RAY**  
**PRIMARY EXAMINER**  
**GROUP 2300**